

## Attachment 2

FIRST OFFICE ACTION OF THE STATE INTELLECTUAL PROPERTY OFFICE, CHINA

## (TRANSLATION)

Date of Issuance: 2 December 2005

Appl. No.:02815148.8

After the examination, the examination comments are as follows:

1. Claim 1 lacks the inventiveness, and does not comply with the provision of Paragraph 3 of Article 22 of PRC Patent Law.

Claim 1 seeks for the protection of an add-on card for detachably coupling to a processing system. Actually, a processing unit is added to the add-on card of the prior art. In view of this processing unit, the add-on card can independently perform the functions that the processing system cannot, and can transmit the non-processed or processed data between the add-on card and the processing system. Citation 1, US6047342A, disclosed the following technical contents (refer to Line 40 of Column 1 to Line 37 of Column 2, Lines 12-33 of Column 3, Lines 25-37 of Column 4, Column 7 and Lines 20-52 of Column 9 of the specification, and Figure 4): an apparatus for providing additional functionality to a computer system (PC processing card) which includes a PC card interface, a processing component which performs the desired actual function (equivalent to the processing unit of the present invention), and a ROM (equivalent to the program storage memory). Taking the PC card being desired to provide DVD decoding function to the host computer as an example, the processing component is the DVD decoder for receiving DVD data, and providing decoding function to the host computer. Furthermore, the PC processing card may include another CPU to provide parallel processing capabilities. It is thus clear that Citation 1 disclosed most of the technical features of Claim 1 and disclosed providing a separate processing component on the PC card to provide additional capabilities to the host computer (the processing system) connected. The only difference between Claim 1 and Citation 1 is that Claim 1 includes a mass storage memory which actually can be regarded as an extension of the program storage memory, can be used to store the processing program, and can be used to store the processed data result. In other words, it is actually a fixed storage memory for storing data. However, the added-on card having a mass storage memory, for example a flash memory, is a common knowledge in the art. External add-on cards, such as flash disk and intelligent cards, all have their own mass storage



6. Claim 26 does not have the inventiveness, and does not comply with the provision of Paragraph 3 of Article 22 of PRC Patent Law.

Similarly, Citation 1 also disclosed that (refer to Line 40 of Column 1-Line 37 of Column 2, Line 12-33 of Column 3, Line 25-37 of Column 4, Column 7 and Line 20-52 of Column 9 of the specification, and Figure 4): to provide a processing component to the PC card (the additional card), and connect the PC card to the host computer, process the data (may be a DVD video flow) transmitted from the host computer using said processing component (which may be a DVD decoder), then provide processed data to the host computer. Thus, it can be seen that most of the technical features in Claim 26 have been disclosed in Citation 1. A sole difference between the claim and Citation 1 is that said add-on card also includes a non-volatile mass storage memory. According to this distinct technical feature, it can be held that the technical problem needed to be solved is actually to store the data transmitted from the host computer to said add-on card. However, using a non-volatile mass storage memory, for example a flash memory, to store is the common knowledge in the art (for example, flash disk, intelligent card, and etc.). Persons having ordinary skills in the art can get the technical solution sought to be protected in Claim 26 by combining Citation 1 with the common knowledge known in the art. This combination is obvious and does not have prominent substantive features or represents a notable progress. Thus, Claim 26 does not have the inventiveness.

7. Claims 27-35 lack the inventiveness, and do not comply with the provision of Paragraph 3 of Article 22 of PRC Patent Law.

The technical solution disclosed in Citation 1 is that PC card provides the functions that the host computer does not have (DVD decoding process) and processes the DVD video flow data (compressing/decompressing, encrypting/decrypting). Thus, it can be seen that the additional technical features defined in Claims 27, 29, 30 and 32 have been disclosed in Citation 1. Claims 27, 29, 30 and 32 lack the inventiveness as stipulated in Paragraph 3 of Article 22 of PRC Patent Law if the claim from which Claims 27, 29, 30 and 32 depend does not have the inventiveness.

The additional technical features defined in Claims 28, 31 and 33-35 are common knowledge known in the art. Citation 1 has disclosed (refer to Line 40 of Column 1-Line 37 of Column 2, Line 12-33 of Column 3, Line 25-37 of Column 4, Column 7 and Line 20-52 of Column 9 of the specification, and Figure 4) that: the host computer provides data to the PC card, then the processing component in the PC card processes the provided data. Said PC card may have technical solutions of various functions. For these various functions (applications), these applications are actually performed by running different software in the processing components. Selecting one or more

- 4 -

applications from these applications is obviously a common knowledge known in the art. In addition, as described above, using non-volatile mass storage memory is also knowledge known in the art. Thus Claims 28, 31 and 33-35 lack the inventiveness as stipulated in Paragraph 3 of Article 22 of PRC Patent Law if the claim from which Claims 28, 31 and 33-35 depend does not have the inventiveness.

8. Similarly, Claims 36-42 lack the inventiveness as stipulated in Paragraph 3 of Article 22 of PRC Patent Law.

Citation 1 has disclosed that (refer to Line 40 of Column 1—Line 37 of Column 2, Line 12-33 of Column 3, Line 25-37 of Column 4, Column 7 and Line 20-52 of Column 9 of the specification, and Figure 4): the technical solution of adding an independent processing component to the add-on card (PC card). After connecting the PC card to the host computer, the host computer provides the data to said PC card. The processing component processes the provided data and returns the processed data to the host computer. Thus, it can be seen that a sole difference between Claim 36 and Citation 1 is the non-volatile mass storage memory. According to this technical feature, it can be held that the technical problem needed to be solved is actually to store the data transmitted from the host computer or the processed data to said add-on card. However, using a non-volatile mass storage memory, for example a flash memory to store is a common knowledge known in the art (for example, a flash disk, an intelligent card, and etc.). Persons having ordinary skills in the art can get the technical solution sought to be protected in Claim 36 by combining Citation 1 with the common knowledge known in the art. This combination is obvious and does not have prominent substantive features or represents a notable progress. Thus Claim 36 does not have the inventiveness.

Similarly, Claims 37-42 lack the inventiveness as well. (Refer to the comments on Claims 27-34.)

9. Claims 43-50 lack the inventiveness and do not comply with the provision of Paragraph 3 of Article 22 of PRC Patent Law.

Claim 43 seeks for the protection of a method of a host system to which an add-on card can be detachably coupled. Citation 1 disclosed the following technical contents (refer to Line 40 of Column 1—Line 37 of Column 2, Lines 12-33 of Column 3, Lines 25-37 of Column 4, Column 7 and Lines 20-52 of Column 9 of the specification, and Figure 4): said PC card coupled to the host computer includes a processing component, and can be used to perform different functions. After connecting to the host computer, receives the data from the host computer and performs corresponding process, and finally transmits the processed data to the host computer. Thus, it can be seen that a sole difference between Claim 43





functions, so that different functions can be performed in different situations. Persons having ordinary skills in the art can get the technical solution sought to be protected in Claim 51 by combining Citation 1 with the common knowledge known in the art. This combination is obvious and does not have prominent substantive features and represent a notable progress. Thus Claim 51 does not have the inventiveness.

Moreover, Citation 1 disclosed the technical content that said PC card can perform the functions of compressing/decompressing and encrypting/decrypting. Thus, it can be seen that the additional technical features defined in Claims 52 and 53 have been disclosed in Citation 1. Claims 52 and 53 lack the inventiveness stipulated in Paragraph 3 of Article 22 of PRC Patent Law if the claim from which it depends does not have the inventiveness.

11. Claims 54 and 55 lack the inventiveness and do not comply with the provision of Paragraph 3 of Article 22 of PRC Patent Law.

Claim 54 seeks for the protection of a method of a host system to which an add-on card can be detachably coupled. Citation 1 disclosed (refer to Line 40 of Column 1-Line 37 of Column 2, Lines 12-33 of Column 3, Lines 25-37 of Column 4, Column 7 and Lines 20-52 of Column 9 of the specification, and Figure 4) the following technical contents: said PC card coupled to the host computer includes a processing component, and can be used to perform different functions. After being connected to the host computer, said PC card receives the data from the host computer and performs corresponding process, and finally transmits the processed data to the host computer. Said PC card have the capability of parallel processing with the host computer. Thus, it can be seen that a sole difference between Claim 54 and Citation 1 is that a plurality of applications are stored in the PC card. Citation 1 has disclosed that said PC card can perform technical solutions for different applications. It is obviously common knowledge known in the art that storing a plurality of software in the PC card simultaneously performs plurality of functions, so that different functions can be performed in different situations. Persons having ordinary skills in the art can get the technical solution sought to be protected in Claim 54 by combining Citation 1 with the common knowledge known in the art. This combination is obvious and does not have prominent substantive features and represent a notable progress. Thus Claim 54 does not have the inventiveness.

Moreover, Citation 1 disclosed that said PC card can perform different functions according to commands from the host computer, for example, decompressing, decoding and decrypting. The data needed to be processed is provided by the host computer to said PC card. Thus, it can be seen that the additional technical features defined in Claim 55 has been disclosed in Citation 1. Claim 55 does not have the inventiveness as stipulated in Paragraph 3 of Article 22 of PRC



**理律法律事務所**  
**LEE AND LI**  
**ATTORNEYS-AT-LAW**

Patent Law if the claim from which Claim 55 depends does not have the inventiveness.

12. Claims 56 and 59 lack the unity with Claim 1 and do not comply with the provision of Paragraph 1 of Article 31 of PRC Patent Law.

From the comment above, it can be seen that Citation 1 has disclosed the technical solution of adding a processing component to the add-on card to perform certain functions. For example, it can provide some functions that the host computer does not have. Thus, it can be seen that adding processing component in the add-on card has been disclosed in the prior art, and is not a special technical feature that does contribute to the prior art. Thus, Claims 56, 59 and 1 lack the special technical feature that does contribute to the prior art and thus lack the unity.

Based on the above, it can be seen that Citation 1 has disclosed the technical idea of adding an independent processing component to the add-on card to perform the functions that the connected host computer does not have (or it can parallel process a certain task together with said host computer.) If an inventive point of the present invention is to provide an independent processing component to the add-on card to perform various functions, the present invention is not inventive no matter how the invention is amended. In view of the above, Claims 1-55 of the present invention lack the inventiveness. The present application will be rejected if the applicant cannot provide sufficient reasons why the present invention is inventive within the time limit prescribed in this notice.

## Attachment 3

## PRC Patent Law:

Article 22

Any invention or utility model for which patent right may be granted must possess novelty, inventiveness and practical applicability.

Novelty means that, before the date of filing, no identical invention or utility model has been publicly disclosed in publications in the country or abroad or has been publicly used or made known to the public by any other means in the country, nor has any other person filed previously with the Patent Administration Department Under the State Council an application which described the identical invention or utility model and was published after the said date of filing.

Inventiveness means that, as compared with the technology existing before the date of filing, the invention has prominent substantive features and represents a notable progress and that the utility model has substantive features and represents progress. (Emphasis added.)

Practical applicability means that the invention or utility model can be made or used and can produce effective results.

Article 31

An application for a patent for invention or utility model shall be limited to one invention or utility model. Two or more inventions or utility models belonging to a single general inventive concept may be filed as one application. (Emphasis added.)

An application for a patent for design shall be limited to one design incorporated in one product. Two or more designs, which are incorporated in products belonging to the same class and are sold or used in sets, may be filed as one application.